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|--|--|---|--|---|--|---|--|-------------------------|--------------------------------------|
| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number (Optional) CE12442JME | | | | | | | |
| I hereby certify that this correspondence is being electronically transmitted on the date listed below [(37 CFR 1.8(a)). on: <u>April 16, 2007</u> Signature <u>/Larry G. Brown/</u> <u>Larry G. Brown</u> Typed or printed name | | <table border="1" style="width: 100%; border-collapse: collapse;"> <tr> <td style="padding: 5px;">Application Number 10/786,945</td> <td style="padding: 5px;">Filed February 24, 2004</td> </tr> <tr> <td colspan="2" style="padding: 5px;">First Named Inventor James L. Tracy</td> </tr> <tr> <td style="padding: 5px;">Art Unit 2618</td> <td style="padding: 5px;">Examiner Vuong, Quochien B</td> </tr> </table> | | Application Number 10/786,945 | Filed February 24, 2004 | First Named Inventor James L. Tracy | | Art Unit 2618 | Examiner Vuong, Quochien B |
| Application Number 10/786,945 | Filed February 24, 2004 | | | | | | | | |
| First Named Inventor James L. Tracy | | | | | | | | | |
| Art Unit 2618 | Examiner Vuong, Quochien B | | | | | | | | |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheets(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table style="width: 100%;"> <tr> <td style="width: 50%; vertical-align: top;"> <input type="checkbox"/> applicant inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registraton number <u>45,834</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34: _____ </td> <td style="width: 50%; vertical-align: top;"> <u>/Larry G. Brown/</u> Signature <u>Larry G. Brown</u> Typed or printed name <u>(954) 723-6449</u> Telephone number <u>April 16, 2007</u> Date </td> </tr> </table> <p>NOTE: Signatures of all the inventors or assignees or record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, se below*</p> | | | | <input type="checkbox"/> applicant inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registraton number <u>45,834</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34: _____ | <u>/Larry G. Brown/</u> Signature <u>Larry G. Brown</u> Typed or printed name <u>(954) 723-6449</u> Telephone number <u>April 16, 2007</u> Date | | | | |
| <input type="checkbox"/> applicant inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registraton number <u>45,834</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34: _____ | <u>/Larry G. Brown/</u> Signature <u>Larry G. Brown</u> Typed or printed name <u>(954) 723-6449</u> Telephone number <u>April 16, 2007</u> Date | | | | | | | | |
| <input type="checkbox"/> *Total of <u>1</u> forms are submitted. | | | | | | | | | |

(SB/33 (07-05))

UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(S): James L. Tracy GROUP ART UNIT: 2618
 APPLN. NO.: 10/786,945 EXAMINER: Vuong, Quochien B
 FILED: February 24, 2004 Confirmation No. 3815
 TITLE: INDEPENDENTLY ACTUATING ELECTRONIC COMPONENTS
 AND METHOD OF OPERATING THEREFOR

| CERTIFICATE UNDER 37 CFR 1.8(a) | |
|---|------------------|
| I hereby certify that this correspondence is being electronically transmitted on the date listed below: | |
| Date: | April 16, 2007 |
| Signature | /Larry G. Brown/ |
| Typed or printed name: | Larry G. Brown |

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop: **AF**
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

Sir:

Applicants request review of the Final Office Action mailed January 23, 2007 concerning the above-identified application in furtherance of the Notice of Appeal filed on April 13, 2007. Claims 1-3 and 5-20 remain pending in the application, a copy of which can be found in Applicants' Amendment of November 2, 2006. Claims 1-3 and 5-20 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. In addition, claims 1-3, 5, 7-12, 14-18 and 20 were rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,760,600 to Nickum (Nickum). Finally, claims 6, 13 and 19 were rejected under 35 U.S.C. 103(a) as

being unpatentable over Nickum in view of U.S. Patent Application Publication No. 2002/0132585 to Palermo, et al. (Palermo).

35 U.S.C. 112, First Paragraph Rejection

In the amendment of November 2, 2006, Applicants amended independent claim 1 by clarifying that each of the peripheral devices operates with its own separate and independent relationship with the electronic host device once decoupled from the electronic host device. Independent claims 9, 10 and 16 were similarly amended. Applicants contest the Examiner's 112 rejection.

The purpose of section 112, first paragraph, is to ensure that there is an adequate disclosure of the invention for which patent rights are sought. Kennecott Corp. v. Kyocera Int'l., Inc., 835 F.2d 1419, 1421 (Fed. Cir. 1987). Generally, although the applicant does not have to describe exactly the subject matter claimed, the description must clearly allow persons of ordinary skill in the art to recognize that the applicant invented what is claimed. In re Daniels, 144 F.3d 1452, 1456 (Fed. Cir. 1998).

Here, in the specification, Applicants have clearly stated that the peripheral device can be automatically activated upon being decoupled from the electronic host device (see page 3, lines 11-12 of paragraph 0008). Moreover, there is clear support for the peripheral device activating independently of any other peripheral device (or devices) and that any combination of peripheral devices can operate concurrently and independently with their own separate relationship to the electronic host device (see page 3, lines 12-14 to page 4, line 1 of paragraph 0008). It is also without question that the specification describes the step of activating a new wireless link between the

electronic host device and the peripheral device in response to detecting the selective decoupling from the electronic host device (see page 4, lines 3-5 of paragraph 0008).

Moreover, the specification reads that the peripheral device can be automatically activated upon being decoupled from the electronic host device and that a new wireless link can be activated between the electronic host device and the peripheral device in response to detecting the selective decoupling from the electronic host device (see page 7, lines 10-14 of paragraph 0020). Immediately following this passage, it is noted in the specification that the peripheral device can activate independently of any other peripheral device and that any combination of peripheral devices can operate concurrently and independently with their own separate relationship to the electronic host device (see page 7, line 14 to page 8, line 2 of paragraph 0020).

Admittedly, the specification does not *expressly* note that the peripheral device operates with its own separate and independent relationship once decoupled from the electronic host device, as pointed out in the Examiner's arguments (see page 2 of the Final Office Action of January 23, 2007). Applicants submit, however, that one of skill in the art would clearly understand that such a feature is supported by the specification. In particular, as noted above, the specification plainly describes that any combination of peripheral devices can operate concurrently and independently with their own separate relationship to the electronic host device. This feature is described immediately after the text relating to the independent activation of the peripheral device once the peripheral device is decoupled. A person of skill in the art would recognize that operation of the peripheral devices with separate relationships to the host device would occur after decoupling and that incessantly noting that this process occurs after decoupling would be superfluous.

As further support and as noted earlier, it is clearly written in the specification that a new wireless link may be initiated between the peripheral device and the host device after decoupling. One of skill in the art would recognize that this activation is in fact an example of an independent and separate relationship between the peripheral and host devices that occurs after decoupling. In view of the above, Applicants submit that there is adequate disclosure of the invention for which patent rights are sought

Independent Claims 1, 9, 10 and 16

Independent claim 1 now recites that each of the peripheral devices operates with its own separate and independent relationship with the electronic host device once decoupled. Independent claims 9, 10 and 16 recite similar subject matter. Applicants respectfully submit that neither Nickum nor Palermo describe such a concept. Specifically, Nickum never describes the cellular telephone (14) or the pager (16) having any sort of relationship with the portable computer (12) once the cellular telephone (14) or the pager (16) is decoupled from the portable computer (12). That is, Nickum consistently describes interaction between the portable computer (12), the cellular telephone (14) and the pager (16) as occurring when the three components are physically coupled to one another (see, e.g., col. 2, lines 34-43; col. 3, lines 24-33; and col. 5, lines 6-13). Even in this description, any interaction between the pager (16) and the portable computer (12) is done through the cellular telephone (see, e.g., col. 4, lines 5-15), as there is no interaction between the computer (12) and the pager (16) independent of the telephone (14).

Moreover, Applicants note that Nickum clearly states that two digital signal processors (42, 44) may be built in the cellular telephone (14) to assist in the control of the communication and power connection interfaces between the pager (16) and the

cellular telephone (14), as well as between the cellular telephone (14) and the portable computer (12) (see col. 4, lines 57-62). Again, the pager (16) is completely dependent on the cellular telephone (14) to exchange information with or receive power from the portable computer (12) when the pager (16) is coupled to the cellular telephone (14), which must be coupled to the computer (12). This configuration teaches away from any thought of both the cellular telephone (14) and the pager (16) having their own separate relationships with the computer (12) when they are decoupled.

Conclusion

In view of the above, Applicants contend that the claims are patentable over the cited prior art references. Reconsideration and withdrawal of the rejection of the claims is respectfully requested. Passing of this case is now believed to be in order, and a Notice of Allowance is earnestly solicited.

The Commissioner is hereby authorized to charge any necessary fee, or credit any overpayment, to Motorola, Inc. Deposit Account No. 50-2117.

Respectfully submitted,

Date: April 16, 2007

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